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REMARKS

Claims currently pending in the application are claims 1 - 4. By the present amendment, claims 1 - 4 are cancelled, and replaced with new claims 5 - 14.

Claim 5 is a new independent claim with limitations that closely resemble the limitations of cancelled claim 2 in independent form. Claims 6 - 14 are dependent on claim 5.

The first sentence in paragraph 0014 in the specification has been amended for the sake of clarity.

Claim Rejection – 35 USC §102

The Examiner has rejected claims 1 - 3 under 35 USC §102(b) as being anticipated by U.S. Patent 750,221 (Reis).

Regarding claim 1, the Examiner is of the view that Reis discloses a hand tool for scribing, marking or cutting materials, consisting of a longitudinal body (B), an offset analog member (H) attached to one end of the body and an instrument holder (C) which is slidably and stopably mounted on the body (Figure 1).

By the present amendment, applicant has cancelled claim 1.

Regarding claim 2, the Examiner is of the view that Reis further discloses a tool in which the analog member performs the function of following an outside edge but could also serve as an inside edge if so desired.

By the present amendment, applicant has cancelled claim 2; however, new independent claim 5 includes limitations that parallel those of claim 2. Accordingly, submissions are made herein in support of the patentability of claim 5 in light of the Examiner's position in respect of the limitations in claim 2. Applicant respectfully

submits that the subject matter in claim 5 is not anticipated by Reis for the reasons below.

The standard for an anticipation rejection under 35 U.S.C. §102 has been well established by the Court of Appeals for the Federal Circuit: a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. In addition, the identical invention must be shown in as complete detail as is contained in the claim. For a prior art reference to anticipate a claimed invention, every element of the claimed invention must be identically shown in a single reference, and these elements must be arranged as in the claim under review.

Applicant submits that claim 5 in the instant application recites that the analog member includes structural limitations of both a corner follower and an edge follower which enable the one tool to perform the dual functions of following either an inside corner or an outside edge. In contrast, Reis discloses a device having only the analogous structure of an outside edge follower (H) for following the edge of a piece of fabric or material. The description in Reis at column 2, line 61 provides that the plate is placed on the fabric or material to be marked and the elbow H is hooked over the edge portion of the fabric or material, whereupon the plate A is moved over the fabric or material, being guided true by the elbow. Nowhere does Reis describe, or even suggest, an additional structural element of an inside corner follower on the elbow. Accordingly, applicant respectfully submits that Reis does not show the identical invention as claimed in claim 5, neither expressly nor inherently; thus, Reis does not anticipate the subject matter in this claim. Applicant respectfully submits that claim 5 is patentable over Reis.

Applicant submits that claims 6 – 14 derive patentability from their dependence, either directly or indirectly, on claim 5.

Applicant is grateful for the Examiner's indication of allowable subject matter. However, applicant respectfully submits that, for the reasons above, he is entitled to broader claim scope than that initially offered by the Examiner.

Conclusion

Attached hereto is a marked-up version of the changes made to the specification by the current amendment. The attached page is captioned "Version with markings to show changes made."

Applicant respectfully requests that a Notice of Allowance be issued in this case.

Respectfully submitted,

A handwritten signature in cursive script, reading "Robert T. Allen". The signature is written in black ink and is positioned above a horizontal line.

Robert T. Allen

Applicant



Application No. 10/615,940

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

Please replace paragraph 0014, with the following rewritten paragraph:

[0014] In the advantageous embodiment of the inside/outside scribe, as seen in the drawings, the tool consists of an elongate body 1, made of a rugged material such as stainless steel, which is bent and formed at one end thereof, creating an analog member which includes an edge follower 9, and a corner follower 10. Upon the body is mounted a sliding and fixable instrument holder 2, made of suitable material, such as anodised aluminium, which holds, adjustably and releasably, by means of a thumbscrew 5, screwed into threaded hole 13, marking cutting or other instruments which are inserted through hole 3, and adjusted for intended use. Scales 11, are etched into and printed onto the face side of the body 1. The instrument holder 2, is slidably and stopably mounted on the body 1, by means of a large, machined or cast metal or moulded polymer, (with inserted, threaded metal stud), shouldered thumbscrew 4, which passes through a slot 12, cut out of the body 1 and is screwed into threaded hole 13, of the instrument holder 2. The thickness of the instrument holder 2, is advantageously equal to the distance between the corner follower 10, and the edge follower 9, thereby creating a relationship between the far cursor edge 8, and the corner follower 10, whereby the distance from the corner follower 10, to the centre-line of an instrument being held in hole 3, of the instrument holder 2, can be directly read, adjacent to the far cursor edge 8, on the preferred, etched and inked scale 11, which is aligned with a plane parallel to the edge follower 9, and laying halfway between the edge follower 9, and the corner follower 10, and represents zero. A corollary relationship therefor exists between the near cursor edge 7, and the edge follower 9, whereby the distance from the edge follower 9, to the centre-line of an instrument mounted in the instrument holder 2, may be directly read on the scale 11, adjacent to the near cursor edge 7. A nub 6, protrudes from the bottom of the instrument holder 2, which acts to align the instrument holder 2, in the slot 12, as it is mounted on the body 1. A plane formed by the centre-

line of the held instrument and the corner follower 10, is roughly parallel to the main portion of the body, insuring relative accuracy of performance as the tool may be held at an approximate right angle to straight edges and adjacent surfaces and normal to curved edges and surfaces.